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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,376	05/23/2007	Amit Gal-On	15872.018	5473
27887	7590	09/03/2008	EXAMINER	
FENNEMORE CRAIG			ZHENG, LI	
3003 NORTH CENTRAL AVENUE				
SUITE 2600			ART UNIT	PAPER NUMBER
PHOENIX, AZ 85012			1638	
			MAIL DATE	DELIVERY MODE
			09/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/590,376	GAL-ON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	LI ZHENG	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 May 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 68-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 68-130 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim(s) 68-69, 71-79, and 127-130 drawn to a plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the at least one segment of the viral genome encodes a viral coat protein.

**Group II**, claim(s) 68-70, 80-94 drawn to a plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the transgenic rootstock resistant to viral disease comprises a DNA construct designed for generating siRNA.

**Group III**, claim(s) 68-69, 95-96 and 99, drawn to a plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the transgenic rootstock comprises a nucleic acid sequence at least

90% identity to at least one segment of the viral genome and wherein the nucleic acid sequence further comprises at least one expression control sequence.

**Group IV**, claim(s) 68-69, 97-98, drawn to a plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the transgenic rootstock comprises a nucleic acid sequence at least 90% identity to at least one segment of the viral genome and wherein the nucleic acid sequence further comprises a selection marker.

**Group V**, claim(s) 100-101, 103-111, drawn to a method for producing a plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the transgenic rootstock comprises a nucleic acid sequence at least 90% identity to at least one segment of the viral genome.

**Group VI**, claim(s) 100-102, 112-126, drawn to a method for producing a plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the transgenic rootstock resistant to viral disease comprises a DNA construct designed for generating siRNA.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the inventions of Groups I-VI is a grafted plant comprising a transgenic rootstock resistant to a viral disease and a scion susceptible to the viral disease wherein the at least one segment of the viral genome encodes a viral coat protein.

However, this method is anticipated by Sonoda et al (2000 The Plant Journal 21:1-8). Sonoda et al. teach that a grafted tobacco plant comprising a transgenic rootstock resistant to SPFMV-S and a scion susceptible to SPFMV-S wherein the at least one segment of the viral genome encodes a viral coat protein from SPFMV-S (abstract and the paragraph bridging pages 2-3). Therefore this technical feature does not constitute a special technical feature as defined by PCT Rule 13.2, because it does not define a contribution over the prior art.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Zheng whose telephone number is 571-272-8031.

The examiner can normally be reached on Monday through Friday 9:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Li Zheng/  
Examiner, Art Unit 1638

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